

REMARKS

Status of the Claims

Claims 19-22, 24, 25, and 28-44 are currently pending and under examination. Claims 1-18 have been canceled without prejudice or disclaimer of the subject matter claimed therein. Claims 23, 26, and 27 have been canceled without prejudice or disclaimer of the subject matter claimed therein.

Amendments to the Claims

Claims 19, 22, 29, 25, 26, and 43 have been amended. Representative support for the amendments can be found in the claims, especially claim 22, as originally filed. The amendments to the claims do not add prohibited new matter.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 19-45 are rejected under 35 USC § 112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

The Office Action alleges that claim 19 is unclear for recitation of the phrase “which can be chosen.” This phrase “which can be” has been removed from the claims for consistency in the format of the claims.

The Office Action also alleges that claim 35 is unclear for depending from a canceled claim. Claim 35 has been amended to depend from claim 19.

It is therefore respectfully requested that this rejection be withdrawn.

Rejection under 35 USC § 112, first paragraph

Claims 19-34 and 36-45 are rejected under 35 USC § 112, first paragraph, for allegedly failing to comply with the enablement requirement.

The Office Action alleges that the claims are not enabled for containing subject matter not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. The Office Action alleges that the claims encompass peptides of various lengths attached to a biotin group. The Office Action alleges that Crews (U.S. Patent 6,831,099)

discloses that biotin groups affect the binding specificity of a peptide.

The present invention provides novel compounds that inhibit the proteosome. The working examples of the present invention teach how to make and use the many compounds that fall within the genus of the compounds encompassed by formula (I) (claim 1). Further, the present application also provides description of the necessary steps by which proteosome activity of the compound can be determined and considered to be inhibited. The present invention also provides suitable test material to enable those skilled in the art to determine whether the novel compounds of the present invention inhibits proteosome activity. The present invention describes assays that are well known and are routinely used to determine inhibition of proteosome activity. Accordingly, the present invention has provided substantial working examples that the genus of compounds (I) is enabled and has provided to those skilled in the art sufficient guidance to assess the activity of the compounds encompassed by the claimed invention.

Applicants accordingly submit that the claimed invention is enabled by the specification because the specification provides sufficient guidance and examples to enable the skilled artisan to practice the claimed invention without undue experimentation. For example, the specification provides adequate guidance in the form of assays for determining the binding specificity of various peptides encompassed by the claims. Accordingly, the specification enables the breadth of the claims, and the claimed invention is not unpredictable. Further, Applicants have provided significant working examples with a variety of embodiments that demonstrate success in proteosome inhibition. It is submitted that any further testing would be routine and not undue. As explained in *Ex parte Jackson*,

[t]he test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides reasonable amount of guidance with respect to the direction in which the experimentation should proceed to enable the determination of how to practice a desired embodiment of the invention claimed

217 USPQ 804 (Bd. Pat. App. 1982).

Applicants submit that in addition to providing adequate working examples of the claimed invention, the present application provides adequate guidance to enable a person having ordinary skill in the art to practice the claimed invention with only routine experimentation. It is

therefore respectfully submitted that the claimed invention is enabled by the specification, and that this rejection be withdrawn.

Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration and the timely allowance of the pending claims. A favorable action is awaited. Should the Examiner find that an interview would be helpful to further prosecution of this application, she is invited to telephone the undersigned at their convenience.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **September 9, 2009**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000

Respectfully submitted,
Morgan, Lewis & Bockius LLP

/Sally Teng/

Sally P. Teng, Ph.D.
Registration No. 45,397